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| APPLICATION NO.                                                                            | FILING DATE | FIRST NAMED INVENTOR  | ATTORNEY DOCKET NO.     | CONFIRMATION NO. |
|--------------------------------------------------------------------------------------------|-------------|-----------------------|-------------------------|------------------|
| 09/975,544                                                                                 | 10/11/2001  | William Robert Hanson | 035451-0146 (3683.Palm) | 9410             |
| 26371                                                                                      | 7590        | 04/05/2006            | EXAMINER                |                  |
| FOLEY & LARDNER LLP<br>777 EAST WISCONSIN AVENUE<br>SUITE 3800<br>MILWAUKEE, WI 53202-5308 |             |                       |                         | LEWIS, DAVID LEE |
| ART UNIT                                                                                   |             | PAPER NUMBER          |                         |                  |
| 2629                                                                                       |             |                       |                         |                  |

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                 |               |  |
|------------------------------|-----------------|---------------|--|
| <b>Office Action Summary</b> | Application No. | Applicant(s)  |  |
|                              | 09/975,544      | HANSON ET AL. |  |
|                              | Examiner        | Art Unit      |  |
|                              | David L. Lewis  | 2673          |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 1/19/2006.

2a) This action is FINAL.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-40 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-40 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

|                                                                                                                         |                                                                             |
|-------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date, _____.                                               |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|                                                                                                                         | 6) <input type="checkbox"/> Other: _____.                                   |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claims 23-40 are rejected under 35 U.S.C. 103(a) as being anticipated by Ogura et al. (6189056 B1) in view of Mills et al. (6976111).**

**As in claim 23, Ogura et al. teaches of a portable electronic module for coupling to a host device, comprising: a display housing, figure 1 item 20, figure 7 item (display);**

**a display coupled to the display housing, figure 1 item 21, figure 7 item (display);**

**an interface housing, figure 1 item 10;**

**an interface configured to be removably coupled to the host device, the interface being incorporated into the interface housing, figure 1 item 11, figure 7 item (card connector);**

a processor coupled to the interface and the display, figure 2 item 63, a memory coupled to the processor, **figure 2 item 65, figure 3 item 51C,**

and a power supply coupled to the processor, **figure 2 item 81.**

**However Ogura et al. fails to** specifically teach of connection to a handheld host device or wherein the interface housing is configured to fit a secure digital slot.

**Mills et al. teaches of** the connection of a accessory expansion module having the PCMCIA slot to a PDA type device, **column 3 lines 40-55, column 13 lines 40-63.** wherein direct connections between PDA's and video display devices to taught, including portable to mobile phone device connections. Mills further teaches wherein the PDA connection interface includes to slot configured to accept an interface housing of an expansion device structured as removable memory, column 6 lines 40-67, figure 20 and 25, item 130.

**Therefore it would have been obvious** to the skilled artisan at the time of the invention to connect to the device as taught by Ogura et al. to the PDA host device as suggested by Mill et al., because Mills et al. teaches a PDA to mobile phone connection for the purpose of expanding functionality can be achieved by using the interface provided for removable memory, such as secure digital, as found in claim 23.

**As in claims 24, Mills et al. teaches of**, wherein the memory includes Secure Digital (SD) memory, column 6 lines 40-45.

**As in claim 25, Ogura et al. teaches of**, wherein the interface is configured to be coupled to a slot in a housing of the handheld computer, figure 3 item 11.

**As in claim 26, Ogura et al. teaches of**, wherein the interface is configured to exchange data with a host device through electrical interconnects, figure 3 item 11.

**As in claim 27, Ogura et al. teaches of**, wherein the interface is configured to exchange data with a host device through an optical data link, figure 2 item 71, inherent to interface application.

**As in claim 28, Ogura et al. teaches of**, wherein the display module is powered by an internal battery, column 13 lines 17-22.

**As in claim 29, Ogura et al. teaches of** wherein the display module is configured to receive power from a host device through the interface, figure 7 item (card connector).

**As in claim 30, Ogura et al. teaches of**, wherein the interface housing is foldably connected to the display housing, figures 1-3 item 30, column 2 lines 35-45.

**As in claim 31, Ogura et al. teaches of**, wherein the display module is configured to be received by a host device when the interface housing is folded behind the display housing, figure 7, column 2 lines 35-45.

**As in claim 32, 33, and 38, Mills et al. teaches of**, wherein the handheld host device is selected from a number of device types, figure 25, column 13 lines 40-67, column 14, column 15 lines 1-25, column 16 lines 30-52, wherein any missing device types would have been an obvious design choice in view of Mills teaching an expansion to a personal computer, which includes any device having a microprocessor.

**As in claim 34, Ogura et al. teaches of**, wherein the display module further comprises a processing circuit selected from the group consisting of: ASIC, microcontroller, microprocessor, column 14 lines 45-55.

**As in claim 35, Ogura et al. teaches of**, further comprising at least one input/output device, figure 1 item 12.

**As in claim 36, Ogura et al. teaches of**, wherein the at least one input/output device is selected from the group consisting of: touch screens, buttons, dials, switches, and electro-audio transducers, figure 1 items 100.

**As in claim 37, Ogura et al. teaches of,** wherein the display module operates to display information when not coupled to a host device, figure 1 item 21.

**As in claim 39, Ogura et al. teaches of,** further comprising a display controller for controlling the display, column 14 lines 45-55 or figure 1 item 63.

**As in claim 40, Ogura et al. teaches of,** wherein the memory is configured to store and retain data customized to the user, figure 2 item 65 and 66.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites the limitation "the accessory housing" in line 12. There is insufficient antecedent basis for this limitation in the claim. Claim 19 recites the limitation "the display" in line 11. There is insufficient antecedent basis for this limitation in the claim. The proper language must be "added" to claims 1 and 19 to make the claims language proper for all of claims 1-22.

***Response to Arguments***

3. Applicant's arguments filed 1/19/2006 with respect to claims 1-22 are persuasive. Claims 1 and 19 have been rejected as lacking antecedent basis, wherein as in claim 1, "the accessory housing", and as in claim 19, "the display", is not properly supported. The necessary language must be added to make the claims language proper. Claims 23 to 40 have been rejected over Ogura et al. in view of Mills et al.

*Allowable Subject Matter*

4. Claims 1-22 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action. The allowable subject includes that added in the Applicants last amendment to claim 1, wherein the interface housing is hinged to the display housing such that the interface housing can fold behind the display housing and be used to couple to the handheld computer when in the fully folded position, wherein the display is visible when the interface is in the fully folded position and the interface is coupled to the handheld computer. The Examiner recommends this language be added to the rejected claim 23 to place the case in condition for allowance.

*Conclusion*

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the

event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **David L. Lewis** whose telephone number is **(571) 272-7673**. The examiner can normally be reached on MT and THF from 8 to 5. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala, can be reached on **(571) 272-7681**. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is **(571)-273-8300**.
  
7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Examiner: David L. Lewis

April 2, 2006



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